## REMARKS

Claim 1 is amended for purposes of clarifying the invention and putting the claim in better condition for allowance or appeal. The amendment made to claim 1 is not thought to be necessary for purposes of patentability because the original claim language is understood to specify that the network interface card includes the debugger network component and that the protocol stack detects the debugger messages and directs the messages to the debugger network component.

Claim 3 is also amended for purposes of clarifying the invention and putting the claim in better condition for allowance or appeal. The amendment made to claim 3 is not thought to be necessary for purposes of patentability because the original claim language is understood to specify that the non-debugger messages are not communicated to the debugger network component.

Claims 1-21 remain pending in the application. Reconsideration and allowance of the application are respectfully requested.

The Office Action does not establish that claims 1-10, 12-14, 16-19 and 21 are unpatentable under 35 USC §103(a) over "Cardoza" (US patent number 5,630,049 to Cardoza et al.), in view of "Mahler" (US patent number 6,675,218 to Mahler et al.). The rejection is respectfully traversed because the Office Action fails to show that all the limitations are suggested by the references, fails to provide a proper motivation for modifying the teachings of Cardoza with teachings of Mahler, and fails to show that the combination could be made with a reasonable likelihood of success.

The traversals of the claim rejections of the first Office Action and the arguments presented in response to those rejections are maintained and incorporated by reference in this response. The Office Actions does not establish a *prima facie* case of obviousness of claims 1-10, 12-14, 16-19 and 21 over Cardoza in view of Mahler.

The newly cited teachings of Cardoza and Mahler neither teach nor suggest the claimed invention set forth in claim 1. The Office Action alleges that the network layers organized in an OSI-like protocol stack is implied by Cardoza. However, even if this is true, there is no suggestion that the physical through the application layer

are implemented on a network interface card (NIC) and that debugger messages detected in this stack on the NIC are directed to a debugger network component also on the NIC.

The Office Action apparently alleges that Mahler suggests the limitations of the protocol stack being in the NIC and the associated detecting of debugger messages on the NIC and directing the debugger messages to the debugger network component on the NIC. However, the cited teachings of Mahler clearly teach otherwise. For example, Mahler teaches at col. 10, l. 19-29 that packet modification library (PML) kernel code processed trapped packets. The PML kernel code is implemented in kernel space and in user space (col. 6, l. 20). Thus, there is no apparent suggestion of the NIC performing the claimed processing.

The alleged motivation for combining Mahler with Cardoza is improper. The alleged motivation states that "it would have been obvious ... to implement a kernel logic and network interface card at the server system by Cardoza so as to include therein a protocol stack processing unit as taught by Mahler's kernel using Mahler's suggested NIC for processing packets (which is also taught by Cardoza) because it is more feasible to perform kernel debugging activities from the user-level thus as to enabling message routing control such that packets implemented from heterogeneous protocol stack can be differentiated, and readdressed or modified/customized and filtered according to the protocol layer and its intended purposes, i.e., allowing user intervention to customize intended use of packets and taking advantage of a kernel filtering capability such as taught by Mahler's approach and explained in Mahler's background." This alleged motivation simply recites reasons from Mahler and does not identify any compatibility or need in the Cardoza system for Mahler's capabilities. It appears that Cardoza's system has no apparent need for Mahler's capabilities since Cardoza's system is for testing software on a network and would not appear to benefit from Mahler's customized filtering according to the protocol layer as alleged. Therefore, the Office Action does not present sufficient supporting evidence for a motivation to combine Mahler with Cardoza.

Claims 2-7 include further limitations that refine the limitations of claim 1 as described above. Furthermore, the claims include additional limitations that are not shown to be suggested by the Cardoza-Mahler combination. Therefore, the Office

Action fails to show or allege any teaching or suggestion of the limitations of claims 2-7.

Claim 8 is in means plus function format. The Office Action does not show that the Cardoza-Mahler combination suggests the functions of the claims as explained above in regards to claim 1. Furthermore, the Office Action does not consider the structure disclosed in the specification in alleging that the claims are unpatentable. ("the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination." *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994) MPEP 2181). Therefore, claim 8 is not shown to be unpatentable over the Cardoza-Mahler combination.

The Office Action fails to show that the Cardoza-Mahler combination suggests all the limitations of claim 9. For example, the Cardoza-Mahler combination is not show to suggest the limitations of a network interface circuit arrangement coupled to the processor and to the memory, the network interface circuit arrangement configured with a protocol stack and a debugger network component, the protocol stack configured to detect debugger messages received over the network and direct the debugger messages to the debugger network component, and the debugger network component configured to communicate the debugger messages to the debugger control component in the kernel.

The Office Action is mistaken in suggesting that Cardoza's col. 8, l. 55 - col. 9, l. 45 suggests the NIC configured with a the debugger network component that communicates debugger messages to the debugger control component in the kernel. It is respectfully submitted that the Cardoza's described layers are in the OS, not in the NIC as described in col. 9, l. 6-25. Furthermore, Cardoza's device driver is not part of the network interface circuit as claimed. Rather, Cardoza's device driver routines communicate with the network hardware device (col. 5, l. 21-24) and are therefore not part of a NIC.

Claims 10 and 12-14 include further limitations that refine the limitations of claim 9 as described above. Furthermore, the claims include additional limitations that are not shown to be suggested by the Cardoza-Mahler combination. Therefore, the Office Action fails to show or allege any teaching or suggestion of the limitations of claims 10 and 12-14.

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The Office Action fails to show that the Cardoza-Mahler combination suggests all the limitations of claim 16. For example, the combination is not shown to suggest the limitations of identifying in a protocol stack in a network interface card, debugger messages and non-debugger messages received over the network, wherein the network interface card implements a protocol stack that includes layers form a physical layer through an application layer and a debugger network component coupled to the protocol stack. The Office Action seemingly admits that the Cardoza-Mahler combination does not teach these limitations by acknowledging that Mahler performs various packet processing in the kernel. Furthermore, the Office Action concludes, without presenting supporting evidence, that "the steps of identifying and transmitting of non-debugging messages –being processed by an interface card among incoming messages from the user—also obvious because of the very concept to use user intervention by Mahler to enable the kernel to re-route or reject appropriate packets according to their intended protocol or application (e.g., debug or non-debug subsystem) following the same rationale as set forth in claim 1."

As explained above in regards to claim 1, the Office Action does not present any evidence to indicate that Cardoza's system would or could benefit from Mahler's system. Furthermore, there is no suggestion shown in prior art to perform the claimed processing in the NIC as claimed.

Claims 17-19 include further limitations that refine the limitations of claim 16 as described above. Furthermore, the claims include additional limitations that are not shown to be suggested by the Cardoza-Mahler combination. Therefore, the Office Action fails to show or allege any teaching or suggestion of the limitations of claims 17-19.

Claim 21 is in means plus function format. The Office Action does not show that the Cardoza-Mahler combination suggests the functions of the claims as explained above in regards to claim 16. Furthermore, the Office Action does not consider the structure disclosed in the specification in alleging that the claims are unpatentable. Therefore, claim 21 is not shown to be unpatentable over the Cardoza-Mahler combination.

The rejection of claims 1-10, 12-14, 16-19 and 21 over the Cardoza-Mahler combination should be withdrawn because the Office Action fails to show all the limitations are suggested by the combination, fails to provide a proper motivation for

combining the references, and fails to show that the combination could be made with a reasonable likelihood of success.
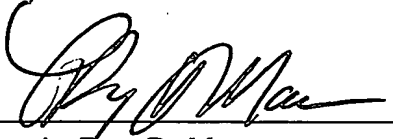
The Office Action fails to show that claims 11, 15, and 20 are unpatentable under 35 USC §103(a) over the Cardoza-Mahler combination as applied to claims 10, 14, and 16, and further in view of US patent number 5,935,262 to Barrett et al. (hereinafter "Barrett"). The rejection is respectfully traversed because the Office Action fails to show that all the limitations are suggested by the references, fails to provide a proper motivation for modifying the teachings of Cardoza with teachings of Mahler, and fails to show that the combination could be made with a reasonable likelihood of success.

The traversals of the claim rejections of the first Office Action and the arguments presented in response to those rejections are maintained and incorporated by reference in this response. Therefore, the Office Actions does not establish a *prima facie* case of obviousness of claims 11, 15, and 20 over the Cardoza-Mahler combination in view of Barrett.

Withdrawal of the rejection and reconsideration of the claims are respectfully requested. No extension of time is believed to be necessary for consideration of this response. However, if an extension of time is required, please consider this a petition for a sufficient number of months for consideration of this response. If there are any additional fees in connection with this response, please charge Deposit Account No. 50-0996 (HPCO.059PA).

Respectfully submitted,

CRAWFORD MAUNU PLLC
1270 Northland Drive, Suite 390
Saint Paul, MN 55120
(651) 686-6633

By: _____
Name: LeRoy D. Maunu
Reg. No.: 35,274

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